

REMARKS

Claim Rejections—35 U.S.C. § 103(a)

Independent claims 17, 21, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Morrison in view of Goldman. It is respectfully submitted that the examiner has not established that any of the independent claims are *prima facie* obvious.

To establish *prima facie* obviousness, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was claimed by the applicant. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Furthermore, a proposed (*e.g.*, by an examiner) modification of a prior art reference does not make that modification obvious unless the desirability of the modification is suggested by the prior art. *See In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Thus, can a claim be obvious if the prior art does not suggest the desirability of the modification of a reference that is proposed by the examiner?

To reject independent claim 17, the examiner asserts that it would have been obvious to modify Morrison with Goldman by providing the medium of Morrison with info segments that can be retrieved at a time not coinciding with receipt of segments of a program. *See* Paper No. 20061111, page 5. Nowhere does either of the cited references propose such a modification.

Morrison does not suggest the desirability of the examiner's proposed modification and the examiner concedes that Morrison does not teach retrieval of an info segment that does not coincide with the receipt of segments of a program. *Id.*, at page 4. That is, Morrison's alleged info segment are program flags that are encoded into program materials. Morrison at column 4, lines 43-46. Generally, the program materials are television broadcast signals. Column 5, lines 4-9. Thus, Morrison inserts program flags in a television broadcast signal and the point at which a break in the program is to occur depends upon the detection of the program break flag in the signal. Column 6, lines 33-35; column 8, lines 19-21. Because Morrison's program break flags are inserted in the broadcast signal, their retrieval is coincident with the retrieval of the program material.

Goldman has nothing to do with inserting an advertisement in television broadcast. Rather, Goldman embeds an advertisement in an HTML document such as web page. *See* column 2, lines 64-67; Figure 3. Thus, Goldman does not suggest providing "the medium of Morrison" with info segments. In other words, the medium of Morrison is a broadcast television

signal and Goldman has nothing to do with inserting advertisements to this medium. Thus, it appears that the examiner has relied on inappropriate hindsight to arrive at the determination of obviousness, which is impermissible. *See In re Fritch* at 1266. In other words, it appears as if the examiner has used claim 17 as a template to piece together the teachings of Morrison and Goldman where neither Morrison or Goldman suggest the modification proposed by the examiner. Accordingly, it is submitted that the examiner has not established a *prima facie* obviousness for claim 17 or claims dependent thereon.

Claim 17 is also not obvious because neither Morrison nor Goldman detect a segment pointer between segments of a plurality of segments of one particular program, and in response thereto, retrieve an info segment from a remote storage. As is explained above, Morrison's program break flags are inserted in content prior to broadcast, therefore the alleged info segment disclosed by Morrison is not retrieved from a remote storage in response to detecting a segment pointer.

Goldman does not cure Morrison's deficiency. For example, the alleged info segment taught by Goldman is user profile information. This information, however, is collected by Goldman's client system and therefore is not retrieved from a remote location. Thus, for this additional reason claim 17 and claims dependent thereon are not obvious.

Furthermore, there is nothing in Goldman that teaches or suggests that user profile information (or ad selection criteria) includes an interruption point specifier that specifies a condition that if detected by a receiver will cause the receiver to display an advertisement in place of a particular content item. That is, the user profile information and ad selection criteria have nothing to do with identifying the timing of when an advertisement will be displayed. Thus, for this additional reason, the examiner has not established *prima facie* obviousness for independent claim 17 or claims dependent thereon.

Under a similar analysis, the examiner has not established *prima facie* obviousness for independent claims 21 and 29. Specifically, with respect to claim 17, the examiner identifies at least Goldman's user profile parameter as disclosing an info segment. Paper No. 20061111, page 5. Although the examiner does not address Goldman's alleged teaching of an info segment with respect to claims 21 and 29, presumably the same portions of Goldman are relied on for

these teachings. Thus, for the reasons explained above, obviousness has not been established for claims 21 and 29 and claims dependent thereon.

Independent claim 19 stands rejected under 35 U.S.C. (a) as being unpatentable over Morrison in view of Ward III and Goldman. For at least the reasons outlined above with respect to the other independent claims, obviousness has not been established for claim 19. Additionally, the examiner does not address the specific language of claim 19; therefore, he has not established obviousness. Furthermore, the cited passages of Ward do not disclose associating, in an electronic programming guide, an info segment with a predetermined one of a plurality of program identifications that are also within the guide. Thus, not all of the limitations of the claim are disclosed by the cited references. Accordingly, claim 19 and claims dependent thereon are patentably distinguished over the cited art.

Other Claim Rejections

Claims 17-20 and 37 stand rejected under §101 and claims 19-20, 29-35 and 39 stand rejected under § 112. These rejections are believed to be overcome by the attached amendments.

CONCLUSION

In view of the amendments and remarks herein, the application is believed to be in condition for allowance. The examiner's prompt action in accordance therewith is respectfully requested. The commissioner is authorized to charge any additional fees, including extension of time fees, or credit any overpayment to Deposit Account No. 20-1504 (BKA.0012US).

Respectfully submitted,

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